

## **REMARKS**

### **STATUS OF THE CLAIMS**

Claims 1, 5-11, 14-16, 19, 22-24, 31, 32 and 34-37 were pending. Claims 2-4, 12, 13, 17, 18, 20, 21 and 25-30 have been canceled. Claims 5, 6, 22, 31, 32, 34, 35, 36, and 37 have been withdrawn from consideration. Thus, claims 1, 5-11, 14-16, 19, 22-24, 31, 32 and 34-37 are pending and claims 1, 7-11, 14-16, 19, 23 and 24 are under active examination.

### **REJECTIONS WITHDRAWN**

Applicants note that the rejections of the claims under 35 U.S.C. § 102(b) and § 103(c) based on Snyder (U.S. Patent No. 5,658,308) have been withdrawn. However, Applicants note that the rejections in the outstanding Office Action make the same rejections but simply substitute U.S. Patent No. 5,957,971 (hereinafter "Schwartz '971") for Snyder.

### **UNDULY PROLONGED PROSECUTION**

Applicants submit that prosecution in this application has been unduly prolonged by the repeated application of non-analogous art and/or redundant references. This case was filed over 6 years ago and, during that time, at least 11 Responses, 2 RCEs and 1 Appeal Brief have been filed. Furthermore, each time Applicants have overcome the applied references, new rejections are made, based on redundant or irrelevant references. Therefore, as clearly set forth in M.P.E.P. § 706.07 (emphasis added), the Office has not met their burden of bringing prosecution to a speedy conclusion:

**To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in reply to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection.**

In the case at hand, the subject matter claimed has not substantially changed since filing over 6 years ago. However, the Examiner has made and withdrawn rejections over a variety of references that were all available at the time of filing and should have been identified and cited, if applicable, years ago. Thus, prosecution in this case has been unduly prolonged by repeated switching from one set of references to another.

Moreover, the Examiner keeps applying art which does not teach or suggest the vaso-occlusive compositions as claimed. As with all previous rejections, the ones based on Schwartz '971 in the most recent Office Action (and addressed below) have been overcome and the claims should be allowed without further delay.

#### **CLAIM OBJECTIONS**

Claim 7 was objected to for allegedly being of improper dependent form. (Office Action, page 2). It was alleged that it is not proper to have a dependent claim recite a particular member of a Markush group recited in the independent claim.

Applicants traverse the objection to claim 7.

As set forth in 37 C.F.R. § 1.75(c):

(c) One or more claims may be presented in dependent form, referring back to and further limiting another claim or claims in the same application.

Here, claim 7 plainly further limits claim 1 in that it specifies that the claimed subject matter must include a particular member of the Markush group recited in claim 1. Accordingly, claim 7 properly depends from and limits claim 1 and the objection should be withdrawn.

#### **35 U.S.C. § 102(b)**

Claims 1, 7, 11, 19, 23 and 24 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Schwartz '971. (Office Action, page 2). Schwartz was cited for allegedly disclosing "a vaso-occlusive coil for treating aneurysms having a fibrin/thrombus stabilizing molecule, e.g., Factor XIII, bioactive coating (see, figures 1-3 and claims 2 and 3)." *Id.*

In fact, Schwartz '971 is entirely silent as to vaso-occlusive devices, teaching instead the opposite of a vaso-occlusive device, namely a stent. Unlike a vaso-occlusive device which is

implanted to occlude a vessel, a stent is implanted to keep a vessel open. Accordingly, this reference does not in any way teach or describe the claimed subject matter and withdrawal of this rejection is in order.

**35 U.S.C. § 103**

**A. Claims 9 and 10**

Claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over Schwartz '971 in view of U.S. Patent No. 4,414,976 (hereinafter "Schwarz '976"). (Office Action, page 3). Schwartz '971 was cited as above for teaching all the elements of claims 9 and 10 except plasminogen activator inhibitor. *Id.*

For the reasons detailed above, Schwartz '971 does not disclose all the elements of the claimed vaso-occlusive compositions because it relates only to stents. Applicants have previously addressed the differences between vaso-occlusive compositions (as claimed) and stents. Additional evidence, including dictionary definitions, is also of record establishing that stents are the complete opposite of a vaso-occlusive composition. See, Response filed November 22, 2002 (received December 2, 2002) and Appeal Brief (received December 7, 2005). In fact, every previous rejection based on a reference disclosing a stent has been withdrawn by the Office because such references **teach away** from the claimed occlusive compositions.

Thus, for all the reasons of record regarding references that teach coating stents to prevent occlusion, withdrawal of the rejection is in order.

**B. Claim 14**

Claim 14 was rejected as allegedly obvious over Schwartz '971 in view of U.S. Patent No. 6,231,590 (hereinafter "Slaikeu"). (Office Action, page 3). Schwartz '971 was cited as above and Slaikeu was cited for teaching plasma treated devices. (Office Action, page 6).

For the reasons listed above, Schwartz '971 does not disclose and actually teaches away from the claimed subject matter. Accordingly, the rejection cannot be sustained.

**B. Claim 15**

Claim 15 was rejected as allegedly obvious over Schwartz '971 in view of U.S. Patent No. 5,891,192 (hereinafter "Murayama"). (Office Action, page 4). Schwartz '971 was cited as above with regard to claim 14 and Murayama was cited for teaching ion implantation. *Id.*

Since Schwartz teaches away from the claimed occlusive compositions, withdrawal of the rejection is in order.

**C. Claim 16**

Claim 16 was rejected as allegedly obvious over Schwartz '971 in view of U.S. Patent No. 6,526,979 (hereinafter "Nikolchev"). (Office Action, page 4). Schwartz '971 was cited as above and Nikolchev was cited for teaching microtexturing. *Id.*

For the reasons listed above, Schwartz does not teach or suggest the compositions of claim 16 and, therefore, the rejection is untenable.


**CONCLUSION**

For the reasons discussed above, Applicants submit that the claims are in condition for allowance and request early notification to that effect.

If the Examiner has any further issues or wishes to discuss any of the foregoing, she is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,

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